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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,667	10/17/2000	Steven MacWilliams	00725.0360-US-01	3418
22865 7590 09/18/2007 ALTERA LAW GROUP, LLC 6500 CITY WEST PARKWAY SUITE 100 MINNEAPOLIS, MN 55344-7704			EXAMINER GATES, ERIC ANDREW	
			ART UNIT 3722	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-25, 34-37 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to Applicant's amendment filed 30 April 2007.

#### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: in line 9, the word "part" should be replaced with the word "apart".
3. Claim 4 is objected to because of the following informalities: the claim is written in language that is severely disjointed and requires editing.
4. Claim 37 is objected to because of the following informalities: in line 2, the word requires a comma following it.
5. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 5, 8-10, 22, 25, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham (U.S. Patent 2,893,144).
8. Regarding claim 1, Cunningham discloses a label 10 for attaching over an edge of a stock member (not labeled, see figure 1) to insure reliably folding along a fold-line

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(gap between 13 and 14, see figure 2) over said edge the label comprising: a substantially planar (planar being defined as "lying in one plane" by Webster's Online Dictionary) foldable first layer 12 having a first surface (side not visible in figure 2) adapted to being printed on (it is inherent that strip 11, which is identified as a well known transparent sheet material, such as "Scotch" tape, is adapted to being printed on) and a second surface (side visible in figure 2) on the back side of said first surface; and a pair of second layers 13/14 of predetermined widths (as seen in figure 2), each including a material which is permanently attached to the second surface of the first layer (using the adhesive material of the "Scotch" tape), the second surface having an adhesive on an outer surface of the label material, the second layer pairs being spaced apart to define a narrow gap therebetween (as seen in figure 2, also see column 2, lines 12-20), said gap defining a fold-line section in the first layer, said gap being narrower than either of said second layer pairs (see figure 2), thereby providing a way to reliably and predictably fold along said line, wherein when a folding pressure is applied to the label, the label folds along the fold-line section such that the first section of the second layer is attachable to a first side of the stock member and the second section of the second layer is attachable to a second side of the stock member (as seen in figure 2).

9. Regarding claim 4, Cunningham discloses wherein the gap comprises a section of complete separation between each of the two or more second layer sections 13/14 thereby providing visually discernability said fold-line with the gap be more translucent than adjacent portions.

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10. Regarding claim 5, Cunningham discloses wherein the gap comprises a discontinuity in the second layer (between sections 13 and 14).

11. Regarding claim 8, Cunningham discloses wherein the second layer has a thickness wherein neither the first section 13 nor the second section 14 of the second layer bends substantially when the folding pressure is applied to the label (as seen in figure 1, neither section bends when folded, also see column 2, lines 39-44).

12. Regarding claim 9, Cunningham discloses wherein the second layer comprises a material (may be cardboard, see column 2, lines 35-37) which is darker than the material of the first layer (which is transparent).

13. Regarding claim 10, Cunningham discloses wherein the gap is visually discernible through the first layer.

14. Regarding claim 22, Cunningham discloses a label 10 comprising: a first layer 12 of predefined light transmissibility (transparent), having a top surface adapted to being printed on (it is inherent that strip 11, which is identified as a well known transparent sheet material, such as "Scotch" tape, is adapted to being printed on) and a bottom surface; and a second layer 13/14 of a second predefined light transmissibility (cardboard) attached to the bottom surface of the first layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap (see figure 2), each gap defining a visually discernible fold-line section in the first layer as a result of the differential light transmissibility at said gap, the second layer comprising a darker material than the first layer, wherein each gap is discernible through the first layer and indicates the fold-line section of the first layer, the first layer

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folds along the fold-line section when a folding force is applied to the label (see figure 1).

15. Regarding claim 25, Cunningham discloses the gap comprises a section of separation between each of the two or more second layer sections (between sections 13 and 14).

16. Regarding claim 37, Cunningham discloses a label 10 for attaching over an edge of a stock member (not labeled, see figure 1) to insure reliably folding along a fold-line (gap between 13 and 14, see figure 2) over said edge, the label comprising: a substantially planar foldable partially translucent first layer 12 (the transparent layer is at least partially translucent due to the inherent thickness of the tape) having a first surface (side not visible in figure 2) adapted to being printed on (it is inherent that strip 11, which is identified as a well known transparent sheet material, such as "Scotch" tape, is adapted to being printed on) and a second surface on the back side of said first surface; and a pair of second layers 13/14 of predetermined widths, each including material which is permanently attached to the second surface of the first layer (by the adhesive on the tape), the second surface having an adhesive on an outer surface of the label material, the second layer pairs being spaced part to define a gap therebetween (as seen in figure 2), said gap being at least partly translucent (as stated above) and areas having said second layer pairs being of lesser translucency (the areas where layers 13/14 are placed would inherently have lesser translucency than the tape layer 12), thereby defining a visually perceptible fold-line section in the first layer, wherein when a folding pressure is applied to the label, the label folds along the fold-line section such

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that the first section of the second layer is attachable to a first side of the stock member and the second section of the second layer is attachable to a second side of the stock member (as seen in figure 2).

17. Claims 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Turner (U.S. Patent 4,201,403).

18. Regarding claim 35, Turner discloses a method of constructing a label 110 which is easily alignable and predictably foldable along a fold-line 119, the method comprising the steps of: providing a label 110 having a first layer 112 having a top surface 114 adapted to being printable; applying an adhesive 118 configured to form an axial channel, such that it defines a visually discernible gap (as seen in figure 9); wherein the combination of first layer and adhesive has different light transmission properties than the first layer alone (it is inherent that the combination of adhesive and the first layer would have a lower light transmission property than the first layer alone since the combination is thicker), thereby creating a visually discernible gap at the channel; wherein the axial channel is of sufficient width to create a single fold line when a folding force is applied to the label.

19. Regarding claim 36, Turner discloses a method of constructing a label 110 which is easily alignable and predictably foldable along a fold-line 119, the method comprising the steps of: providing a label 110 having a first layer 112 having a top surface 114 adapted to being printable; applying an adhesive 118 configured to form an axial channel, such that it defines a visually discernible gap (as seen in figure 9); wherein the

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combination of first layer and adhesive has different light transmission properties than the first layer alone (it is inherent that the combination of adhesive and the first layer would have a lower light transmission property than the first layer alone since the combination is thicker), thereby creating a visually discernible gap at the channel.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (U.S. Patent 2,893,144).

22. Regarding claim 2, Cunningham discloses the invention substantially as claimed, except Cunningham does not disclose wherein the second layer pairs include an adhesive on an outer surface of the second layer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied an adhesive surface as found on the first layer to the exposed surface of the second layer pairs for the purpose of creating an adhesive bond between the second layer pairs when folded, thereby creating a stronger folded label, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.



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23. Claims 3, 6, 18, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (U.S. Patent 2,893,144) in view of Cunningham (U.S. Patent 3,348,324).

24. Regarding claims 3, 18, and 24, Cunningham '144 discloses the invention substantially as claimed, except Cunningham does not disclose wherein the gap comprises a series of perforations. Cunningham '324 teaches the use of perforations 36/37/38 on a label blank 21 that are used for the purpose of defining a fold line. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the label of Cunningham '144 with the perforations of Cunningham '324 in order to have a label that is easier to fold due to the line of weakness.

25. Regarding claims 6 and 20, Cunningham '144 discloses the invention substantially as claimed, except Cunningham does not disclose wherein the fold-line section is offset from a centerline of the first layer. Cunningham '324 teaches the use of a fold-line 53 that is offset from the centerline of the first layer 47 for the purpose of having text exposed only on one side of the file folder 58. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the label of Cunningham '144 with the offset fold-line of Cunningham '324 in order to have a label that only requires text on one side.

26. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (U.S. Patent 2,893,144) in view of Schneider (U.S. Patent 5,513,459).

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27. Regarding claim 7, Cunningham discloses the invention substantially as claimed, except Cunningham does not disclose wherein the second layer has at least two gaps, or wherein the label is foldable upon a three dimensional tab member, or wherein each gap is visible through the first layer. Schneider teaches the use of a label (as seen in figure 2) that has two fold lines for the purpose of being foldable upon a three dimensional tab member 16. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the label of Cunningham with the double fold-line of Schneider in order to have a label that has two visible gaps for folding onto a three dimensional tab member.

28. Claims 11, 13-17, 19, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (U.S. Patent 2,893,144).

29. Regarding claim 11, Cunningham discloses a label 10 foldable along a fold-line (gap between 13 and 14, see figure 2) comprising: a substantially planar first layer 12 of predetermined light transmissibility (transparent); and a second layer 13/14 of a second predetermined light transmissibility (cardboard) attached to the first layer and having at least two sections at least partially separated by a gap (as seen in figure 2), the gap being visually discernible through the first layer as a result of differential transmissibilities of the different portions of the label; wherein the label fold line can be reliably discerned at said folds along the discernible gap as a consequence of lesser light transmissibility thicker portions on either side of the gap (due to layers 13 and 14) such that the at least two sections are mountable on different surfaces of the stock

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member when the label is applied over an edge of the stock member (as seen in figure 2).

Cunningham does not disclose the second layer having an adhesive on an outer surface for applying the label to a stock member having at least two surfaces. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied an adhesive surface as found on the first layer to the exposed surface of the second layer pairs for the purpose of creating an adhesive bond between the second layer pairs when folded, thereby creating a stronger folded label, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

30. Regarding claim 13, the modified invention of Cunningham discloses wherein the second layer comprises a darker material than the first layer.

31. Regarding claims 14 and 23, the modified invention of Cunningham discloses the invention substantially as claimed, except Cunningham does not disclose wherein the second layer comprises a security label material. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable material into the label for the purpose of using it as a security label, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the second layer with any desired material, since applicant has not disclosed the criticality of using a particular material.

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32. Regarding claim 15, the modified invention of Cunningham discloses wherein the gap indicates a label fold-line for matching with the edge of the stock member (as seen in figure 2).

33. Regarding claim 16, the modified invention of Cunningham discloses wherein the gap defines a fold-line section in the first layer (as seen in figure 2).

34. Regarding claim 17, the modified invention of Cunningham discloses wherein the first layer folds along the fold-line section when a folding force is applied to the label.

35. Regarding claim 19, the modified invention of Cunningham discloses wherein the gap comprises a section of complete separation between each of the two or more second layer sections.

36. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (U.S. Patent 2,893,144).

37. Regarding claim 34, Cunningham discloses a label 10 comprising: a substantially planar first layer 12 of first predetermined light transmissibility (transparent); and a second layer 13/14 of second predetermined light transmissibility (cardboard), permanently attached to the first layer (through adhesive on the first layer), the second layer including a first section 13 and a second section 14 at least partially separated by a gap (as seen in figure 2) which is visually discernible through the first layer, as a result of different light transmissibility at the gap, wherein the label folds along the visually discernible gap such that a user folding the label can predict where the label will fold by perceiving the visually discernible gap through the first layer.

Cunningham does not disclose the second layer having an adhesive on an outer surface of the second layer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied an adhesive surface as found on the first layer to the exposed surface of the second layer pairs for the purpose of creating an adhesive bond between the second layer pairs when folded, thereby creating a stronger folded label, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

#### ***Allowable Subject Matter***

38. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

39. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

40. For the reasons as set forth above, the rejections are maintained.

#### ***Conclusion***

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is (571) 272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG  
12 September 2007

  
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SUPERVISORY PATENT EXAMINER